

REMARKS

Claim 17 has been amended herein to properly correspond same to claim 4. The present amendment is deemed not to add new matter. Claims 1, 4 and 17 remain in the application.

Reconsideration is respectfully requested of the rejection of claims 1 and 4 under 35 U.S.C. 103(a) as being unpatentable over the previously cited Ferrari et al. reference, (US 2003/0068348, published on 04/10/03), the previously cited Tanaka reference (JP 2001-302455, machine translated, published on 10/31/2001, and cited in a previously filed IDS), the newly cited Masuda et al. reference, (WO 02/26198, published on April 4, 2002), the newly cited Yoneyama et al. reference, (US Patent No. 5362482, published on November 8, 1994), and the previously cited Simon reference (US Patent No. 6346256 published on February 12, 2002).

The Examiner's primary reference of Ferrari, et al. discloses a cosmetic composition comprising a liquid lipid phase containing silicone oil and zinc particles. However, as the Examiner has correctly recognized, Ferrari, et al. fail to disclose or suggest many of the claimed components herein, such as the hydrophobic zinc powder claimed herein. In addition, Ferrari, et al. fail to disclose or suggest the specific claimed caprylylmethicone, particularly within the now claimed specific weight ratio, the polyoxyalkene-modified organopolysiloxane, as well as the claimed organic modified clay material of claim 4.

To cure these deficiencies, the Examiner has felt it necessary to cite *four* additional references, namely Tanaka, et al., Simon, Masuda, et al. and Yoneyama, et al. Tanaka, wherein the Examiner has used each reference to provide a teaching of only one of the claimed elements of the present invention. For example, Tanaka, et al. merely disclose hydrophobically treating the zinc

oxide powder, but also fails to disclose the caprylylmethicone in the claimed range herein, as well as the organic modified claim material claimed herein. Simon, although disclosing caprylylmethicone (see column 7, Example 3), fails to disclose the combination of same with hydrophobic zinc oxide powder and 0.5-4 wt% of a polyoxyalkylene-modified organopolysiloxane (i.e., the lipophilic active material). Thus, it is apparent that the instant rejection is a classic multi-reference hindsight rejection, which by law is overcomeable via presentation of secondary considerations, such as unexpected results. It is respectfully submitted that such unexpected results are clearly presented in the instant Specification.

Objective evidence of secondary considerations, such as unexpected results, are relevant to the issue of obviousness and must be considered in every case in which they are present. See MPEP 2141 II. It is the duty of the Examiner to evaluate such evidence. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed.Cir., 1983); and *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed.Cir., 1986), cert. denied, 480 U.S. 947 (1987). Proof of an unexpected improvement can rebut a prima facie case of obviousness. *In re Murch*, 464 F.2d 1051, 175 USPQ 89 (CCPA, 1972). No matter how strong the prima facie case of obviousness made out by the PTO, it must be weighed against any factors to the contrary brought out by the applicant in determining the validity of the conclusion of patentability unobviousness. *In re Lewis*, 443 F.2d 489, 170 USPQ 84 (CCPA, 1971). Therefore, facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion was reached, not against the conclusion itself. *In re Lilly & Co.*, 902 F. 2d 943, 14 USPQ 2d, 1741 (CAFC, 1990).

The present inventors found that adding a (d) lipophilic active material to the sunscreen

cosmetic of the present invention results in a water-in-oil emulsified sunscreen cosmetic that spreads easily, and has a fresh sensation when applied to the skin, consideration not found in any of the **5 cited references**. In addition, it was unexpectedly discovered that by combining (a) the claimed hydrophobic zinc oxide powder (b) a volatile silicone, (c) 1-10 wt% caprylylmethicone, and (d) 0.5-4 wt% of a polyoxyalkylene-modified organopolysiloxane, as illustrated by the test results shown in Table 3, it is possible to obtain a sunscreen cosmetic that has a long lasting coverage effect and excellent ease of washability, and thus they arrived at the present invention. In contrast, as illustrated in Table 3, Comparative Example 1, which does not include the claimed caprylylmethicone, had a noticeably lower ease of washability (see Specification, page 41, line 7, to page 42, line 2).

[Table 3]

	Example 1	Example 2	Comparative example 1	Comparative example 2	Comparative example 3
(e) Ion-exchange water	30.2	—	30.2	30.2	20.2
1,3-butylene glycol	5	—	5	5	5
(b) Octamethylcyclotetrasiloxane	28	47.5	28	28	28
(c) Caprylylmethicone	5	15	—	5	—
Dimethyl silicone (6cs)	—	—	5	—	5
(d) Branched polyether-modified silicone (Shin-Etsu Chemical Co., Ltd. KF-6028)	1	—	1	1	1
(d) Ppolyether-modified silicone (Shin-Etsu Chemical Co., Ltd. KF-6017)	—	—	—	—	—
(a) Hydrophobic zinc oxide powder (Manufacturing Ex. 1)	18	25	—	—	—
5% methyl hydrogen-treated zinc oxide (FINEX-50 made by Sakai Chemical Industry Co., Ltd.)	—	—	18	18	18
Spherical PMMA (Microsphere M306)	5	5	5	5	5
Octylmethoxy cinnamate	7.5	7.5	7.5	7.5	7.5
Edetate	0.1	—	0.1	0.1	0.1
Phenoxy ethanol	0.2	—	0.2	0.2	0.2
Long lasting coverage (water-repelling and oil-repelling characteristics)	◎	○	○	○	○
Ease of washability	◎	○	×	△	△


None of the cited references herein, taken alone or in combination, disclose or suggest the combination of elements now claimed herein, in the ratios now claimed herein, *so as to provide the unexpected results provided by the now claimed water-in-oil emulsified sunscreen cosmetic of the present invention, i.e., long lasting coverage effect and excellent ease of washability, as illustrated by the comparative test data shown in the Specification.* In fact, none of Ferrari, et al., Simon, Yoneyama, et al., Masuda, et al., or Tanaka, et al. concern sunscreen cosmetics, or the issues/problems encountered therewith, as herein in the present application. Rather, these

teachings come only from the present invention, and constitute an important element or aspect thereof.

In view of the legal authorities cited above, as well as the unexpected results pointed out above, it is believed that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

A handwritten signature in black ink that reads "Donald E. Townsend, Jr." in a cursive script.

Donald E. Townsend, Jr.
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